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REMARKS

Forty-two claims remain pending in the present Application. Claims 1-42 stand rejected under 35 U.S.C. § 103(a), and claims 1 and 21 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

Failure To Establish A Prima Facie Case Of Unpatentability

In the Response to the previous Office Action, Applicants maintained that the Examiner failed to properly establish a *prima facie* case of unpatentability. Applicants again respectfully repeat that earlier assertion with regard to the present Office Action, and further point out that, as discussed below, the initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

As support for each of the rejections of Applicants' claims, the Examiner discusses various purported teachings from the cited references. However, the present Office Action also consistently and ambiguously fails to relate the referenced teachings to corresponding specific limitations in Applicants' rejected claims 1-42. For example, in the rejections of claims 1-3, 5-6, 11-23, 25-26, 29, and 31-42, the Examiner nowhere relates any teachings of the cited references to specific claim numbers, and also fails to specifically cite any claimed language or limitations from Applicants' claims 1-42, with the exception of those amendments made by Applicants during their Response to the initial Office Action.

Furthermore, in the rejections of dependent claims 4, 7-10, 24, and 27-30, none of the originally-filed claim limitations have been specifically addressed in either the initial or the present Office Action. Applicants therefore respectfully submit that a requisite *prima facie* case of unpatentability has not been properly established by the Examiner for the rejections of claims 1-42, and that claims 1-42 have therefore not thus far received an adequate examination. Applicants submit that they are unable to respond with appropriate specificity to the current rejections because of the foregoing ambiguities.

Applicants therefore request that the Examiner properly relate the reference teachings to each specific limitation in Applicants' claims 1-42. Applicants also respectfully repeat their request for the Examiner to issue a new non-final Office Action that remedies the foregoing defects for all rejected claims, or in the alternative, to allow the rejected claims so that the present Application may issue in a timely manner.

35 U.S.C. § 103

On page 2 of the Office Action, the Examiner rejects claims 1-3, 5-6, 11-23, 25-26, 29, and 31-42 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,779,549 to Walker et al. (hereafter '549) in view of U.S. Patent No. U.S. Publication No. 2002/0169706 to Chandra et al. (hereafter Chandra). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of '549 according to the teachings of Chandra would produce the claimed invention. Applicants submit that '549 in combination with Chandra fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither '549 nor Chandra contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of independent claims 1 and 21, Applicants respond to the Examiner's §103 rejection as if applied to amended independent claims 1 and 21 that now recite performing "*a trading transaction for negotiating a transfer of ownership rights of an electronic certificate that relates to a*

prize from said electronic gaming, said trading transaction being conducted directly between a source device from said one or more user devices and a target device from said one or more user devices" which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto. Applicants submit that the foregoing amendments are supported by claims 13, 14, and 20, as originally filed, and therefore do not necessitate a new search.

In the present Office Action, the Examiner cites Chandra as support for rejecting Applicants' limitation of "negotiating a transfer". Chandra teaches an e-broker device that *controls* various types of transactions between client devices. More specifically, Chandra teaches that "client devices may participate in . . . trades with other client devices . . . via one or more e-broker devices" (page 4, paragraph 45, lines 1-3).

In contrast, in claims 1 and 21 as amended, Applicants now recite a "trading transaction being conducted directly between a source device from said one or more user devices and a target device from said one or more user devices." Applicants submit that the cited references nowhere teach user/client devices that communicate directly with each other to perform a trading transaction.

In addition, Applicants respectfully submit that the cited references nowhere discuss or teach an "electronic certificate" as recited by Applicants in claims 1 and 21, and as described in substantial detail in the Specification (see pages 22-24). Furthermore, Applicants also submit that the cited references nowhere teach an "*electronic certificate that relates to a prize from said electronic gaming*" as now recited in amended claims 1 and 21. For at least the foregoing

reasons, Applicants therefore submit that the rejections of claims 1 and 21, as amended, are improper.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are further discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof.

Applicants respectfully submit that, in light of the substantial differences between the teachings of the cited references and Applicants’ invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of cited references. Applicants specifically direct the Examiner’s attention to Applicants’ discussion of FIGS. 3, 8, and 11 (Specification, page 13, line 6 through page 16, line 3, page 22, line 24 through page 24, line 3, and page 26, line 30 through page 28, line 18) which describes in detail one embodiment for the Applicants’ claimed “means for managing” and “means for communicating”.

Regarding the Examiner’s rejection of dependent claims 2-20 and 22-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in

combination with the limitations of the respective independent claims, are also not identically taught or suggested.

In addition, with regard to claims 12 and 32, Applicants submit that the cited references fail to teach “wagers for gambling activities”, as claimed by Applicants. The Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-20 and 22-40 so that these claims may issue in a timely manner.

In the rejections of claims 5, 6, 16-20, 25, 26, and 36-40, the Examiner repeatedly makes similar arguments regarding the purported non-criticality of certain elements of Applicants' claims based upon Applicants' discussion of potential alternate embodiments in the Specification. Applicants have never made any representations regarding whether certain elements of their invention are critical or non-critical. However, Applicants respectfully point out that obviousness, not criticality, is the proper standard for determining patentability under 35 U.S.C. § 103(a). Applicants therefore submit that the current rejections are improper, and respectfully request the Examiner to reconsider the current grounds of rejections for claims 5, 6, 16-20, 25, 26, and 36-40, so that these claims may issue in a timely manner.

In the rejections of claims 5, 15, 25, and 35, the Examiner repeated states that various claimed limitations are “well known” as support for the rejections without providing any specific references for support. It appears that the Examiner is utilizing Official Notice without expressly stating so. Applicants respectfully submit that the claimed limitations in the particular claimed

combination were not necessarily well-known to one skilled in the art at the time of the invention. For example, providing a gaming device with the claimed "profile module", "certificate handling module", or "trading module" would seem to provide sufficient "reasonable doubt" for properly questioning the Examiner's use of Official Notice.

Applicants therefore respectfully request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 5, 15, 25, and 35, so that the present Application may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 1-3, 5-6, 11-23, 25-26, 29, and 31-42 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1-3, 5-6, 11-23, 25-26, 29, and 31-42 under 35 U.S.C. § 103.

On page 4 of the Office Action, the Examiner rejects claims 4 and 24 under 35 U.S.C. § 103 as being unpatentable over '549 in view of Chandra, and further in view of U.S. Patent No. 6,409,602 to Wiltshire et al. (hereafter Wiltshire). The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, dependent claims 4 and 24 are indirectly dependent from respective independent claims 1 and 21 whose limitations are not identically taught or suggested. The limitations of these dependent claims, when viewed

through or in combination with the limitations of the respective independent claims, are therefore also not identically taught or suggested.

For at least the foregoing reasons, the Applicants submit that claims 4 and 24 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 4 and 24 under 35 U.S.C. § 103.

On page 5 of the Office Action, the Examiner rejects claims 7 and 27 under 35 U.S.C. § 103 as being unpatentable over '549 in view of Chandra, and further in view of U.S. Patent No. 5,947,825 to Horstmann et al. (hereafter Horstmann). The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, dependent claims 7 and 27 are indirectly dependent from respective independent claims 1 and 21 whose limitations are not identically taught or suggested. The limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are therefore also not identically taught or suggested.

For at least the foregoing reasons, the Applicants submit that claims 7 and 27 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 7 and 27 under 35 U.S.C. § 103.

On page 6 of the Office Action, the Examiner rejects claims 8 and 28 under 35 U.S.C. § 103 as being unpatentable over '549 in view of Chandra, and further in view of U.S. Patent No. 6,389,402 to Ginter et al. (hereafter Ginter). The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, dependent claims 8 and 28 are indirectly dependent from respective independent claims 1 and 21 whose limitations are not identically taught or suggested. The limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are therefore also not identically taught or suggested.

Furthermore, Applicants respectfully submit that Ginter nowhere discusses or teaches an "electronic certificate" as claimed and taught by Applicants. Instead, Ginter only discloses a "container" that is a "logical object structure" which is "a convenient metaphor used to give a name to the collection of elements required to make use of content . . ." (column 127, lines 18-20). Applicants submit that the "container" of Ginter may not accurately be analogized to the claimed "electronic certificate" because both the claimed purpose and the claimed structure are significantly different. For example, Applicants submit that the "container" of Ginter is not related to "electronic gaming" as claimed by Applicants.

In addition, on pages 6-8 of the Office Action, the Examiner repeatedly cites sections of Ginter in support of the rejections of claims 8 and 28. However, Applicants respectfully submit that the cited elements from Ginter are not part of

the disclosed “container”, and therefore are not relevant in the Examiner’s attempt to analogize the “container” disclosed by Ginter with Applicants’ claimed “electronic certificate”. Applicants therefore respectfully submit that the limitations of claims 8 and 28 are not disclosed by Ginter.

Furthermore, the Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that the cited references do not suggest a combination that would result in Applicants’ invention, and therefore the obviousness rejection under 35 U.S.C §103 is improper.

The Examiner states “[i]t would have been obvious . . . to incorporate the ideas of Ginter . . . “in order to provide users with a means to securely and safely trade rights between each other with confidence in the security of such transaction.” Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention cannot act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

For at least the foregoing reasons, the Applicants submit that claims 8 and 28 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 8 and 28 under 35 U.S.C. § 103.

On page 8 of the Office Action, the Examiner rejects claims 9 and 29 under 35 U.S.C. § 103 as being unpatentable over '549 in view of Chandra, and further in view of U.S. Patent No. 6,168,522 to Walker et al. (hereafter '522). The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, dependent claims 9 and 29 are indirectly dependent from respective independent claims 1 and 21 whose limitations are not identically taught or suggested. The limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are therefore also not identically taught or suggested.

For at least the foregoing reasons, the Applicants submit that claims 9 and 29 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 9 and 29 under 35 U.S.C. § 103.

On page 9 of the Office Action, the Examiner rejects claims 10 and 30 under 35 U.S.C. § 103 as being unpatentable over '549 in view of Chandra, and

further in view of Horstmann. The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, dependent claims 10 and 30 are indirectly dependent from respective independent claims 1 and 21 whose limitations are not identically taught or suggested. The limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are therefore also not identically taught or suggested.

For at least the foregoing reasons, the Applicants submit that claims 10 and 30 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 10 and 30 under 35 U.S.C. § 103.

Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-42 so that the present Application may issue in a timely manner.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made." If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: 5/12/03

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Version With Markings To Show Changes Made

In The Claims:

1. (Twice Amended) A system for supporting electronic gaming, comprising:
an event server configured to manage a game service, said event server
providing a restricted access to said game service over an electronic
network; and
one or more user devices configured to communicate with said event server
over said electronic network by performing a wireless communications
procedure to thereby allow one or more system users to participate in
said electronic gaming, said one or more system users each utilizing a
respective one of said one or more user devices to perform a trading
transaction for negotiating a transfer of ownership rights of an electronic
certificate that relates to a prize from said electronic gaming, said
trading transaction being conducted directly between a source device
from said one or more user devices and a target device from said one or
more user devices.

21. (Twice Amended) A method for supporting electronic gaming, comprising the steps of:

managing a game service by utilizing an event server that provides a restricted access to said game service over an electronic network; and communicating with said event server over said electronic network by performing a wireless communications procedure with one or more user devices to thereby allow one or more system users to participate in said electronic gaming, said one or more system users each utilizing a respective one of said one or more user devices to perform a trading transaction for negotiating a transfer of ownership rights of an electronic certificate that relates to a prize from said electronic gaming, said trading transaction being conducted directly between a source device from said one or more user devices and a target device from said one or more user devices.